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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,199	12/07/2001	Motonori Nakamura	50212-317	8188

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MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

HOFFMANN, JOHN M

ART UNIT PAPER NUMBER

1731

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,199

Applicant(s)

NAKAMURA ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because the specification is of poor quality. 1) there are numerous black marks running down the pages which make it impossible to read (see page 2/line2 for instance). 2) the letters in the wording are incomplete (for example, page 2, line 12 – the “t” in “position” 3) many words are crammed together to form line-long nonsense words (example, page 4, line 5, “effectiveportionofth...” is not a word.)

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: line 7 – it is unclear how the “(s)” is suppose to modify the claim. And further looking at the last few lines of the claim – it is unclear if there are suppose to be a plurality of burners.

Claim 1: line 17: there is no antecedent basis for "the direction". First it is noted that there is no requirement that the "movement" has only one direction. Further, since it refers to movement of the starting member AND one or more burners – there is no indication that both are moving in the same direction.

Line 12 refers to setting one marking point: line 20 also refers to a single marking point ("said marking point"). But the last two lines refer to "said marking points". It is unclear if there is one or more marking point required by the claim. Although the specification refers to multiple marking points, but there is no reason to think that Applicant intended to require the claim to have two marking points. Line 21 does not have proper construction: it should be "each...is" or "all...are" (or the like): "each...are" is confusing as to what was intended.

Line 16 (or 15) of claim 1: there is no antecedent basis for "the dummy rod" up to that point, there are two dummy rods – and there is no distinction between them . Furthermore, when trying to interpret the claim in light of the specification, Examiner becomes confused, because the disclosure has the marking points so that they are on the dummy rods. But claim indicates they are "toward" the dummy rod. The customary meaning of the preposition "toward" (in the present context) would be something like "along a course leading to", in other words, the claim requires that the mark is near dummy rod. But if it is on the dummy rod, then it isn't reasonable to consider it "toward" the rod.

Claims 3-4: there is no antecedent basis for "said starting member end portion side": there is not any mention of any side of any side.

Claims 3-4: There is no antecedent for "the soot body formed." It is nothing that requires that the formed body be a soot body.

Claim 2: there is no antecedent basis for "said marking point position". Examiner interprets the term "marking point" to be a position – but this claim seems to suggest that it is actual structure which has a position.

Claim 5: line 14 indicates that there can be just one burner. But line 20 seems to require there be "burners": there is confusing antecedent basis for "said glass synthesizing burners."

Claim 5: the term "glass material" (lines 16-17) is indefinite as to its meaning. One of ordinary skill would think a glass material is either solid glass or molten glass. But the specification indicates that SiCl_4 can be a glass material. But there is no other indication as to what a "glass material" can or cannot be.

Claim 5: last line: there is no antecedent basis for "said marking points." Examiner could only find mention of a single marking point. It is unclear whether the claim is suppose to claim only one or both of the disclosed marking points.

The term "marking points" is indefinite as to its meaning (claims 1-5). The specification (page 3, last full sentence) identifies what is meant by the term of two different 'cases'. However, there is no indication as to what is meant by the term for other cases – such as the case of claim 1 – which is not either of the cases of page 3. There is no "case of stopping..." nor a "case using auxiliary burners". Furthermore, it is unclear whether there must actually be any marks/markings. The term "marking" is misleading if there is no actual mark.

Allowable Subject Matter

Claim 1 defines over the prior art because of the reversing each time when all of the glass synthesizing burners reach the marking point or beyond toward an end of the starting member.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Moriya and Fujimaki are cited as being of general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann

5-7-04

Application/Control Number: 10/005,199

Page 6

Art Unit: 1731

Primary Examiner
Art Unit 1731

jmh